

ESTTA Tracking number: **ESTTA776286**

Filing date: **10/12/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Bayerische Motoren Werke Aktiengesellschaft
Granted to Date of previous extension	10/12/2016
Address	Dept. AJ-55Petuelring 130 Munich, BY 80809 GERMANY
Attorney information	JOHN G FROEMMING JONES DAY 51 LOUISIANA AVENUE NW WASHINGTON, DC 20001 UNITED STATES jbradley@jonesday.com, jfroemming@jonesday.com, kbaird@jonesday.com, nytef@jonesday.com, agaransi@jonesday.com Phone:2028797695

Applicant Information

Application No	86881671	Publication date	06/14/2016
Opposition Filing Date	10/12/2016	Opposition Period Ends	10/12/2016
Applicant	HANGZHOU DONGHUA CHAIN GROUP CO., LTD. NO.1 CHANGDA ROAD HANGZHOU, ZHEJIANG, CHINA		

Goods/Services Affected by Opposition

Class 012. First Use: 2015/11/20 First Use In Commerce: 2015/11/20 All goods and services in the class are opposed, namely: Anti-skid chains for vehicles; Chains for cycles; Chains for motor cars; Clutches for land vehicles; Driving chains for land vehicles; Gear boxes for land vehicles; Land vehicles and structural parts therefor; Shock absorbing springs for vehicles; Tires for vehicle wheels; Transmission chains for land vehicles
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Application No	86881675	Publication date	06/14/2016
Opposition Filing Date	10/12/2016	Opposition Period Ends	
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2867087	Application Date	08/02/2000
Registration Date	07/27/2004	Foreign Priority Date	NONE
Word Mark	X3		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 2004/03/00 First Use In Commerce: 2004/03/00 [Money clips,] key rings, and licenseplates, all made of metal</p> <p>Class 012. First use: First Use: 2004/03/00 First Use In Commerce: 2004/03/00 Passenger motor vehicles and structural parts therefor; [bicycle racks for vehicles]</p> <p>Class 014. First use: First Use: 2004/03/00 First Use In Commerce: 2004/03/00 [Ashtrays, cigarette] [and cigar] [lighters, cigarette] [and cigar] [holders, lapel pins, tie clips, watches, all made of precious metal]</p> <p>Class 016. First use: First Use: 2004/03/00 First Use In Commerce: 2004/03/00 [Appointment books, ball-point pens, and coin holders]</p> <p>Class 018. First use: First Use: 2004/03/00 First Use In Commerce: 2004/03/00 [Umbrellas, luggage, and wallets]</p> <p>Class 025. First use: First Use: 2004/03/00 First Use In Commerce: 2004/03/00 [Shirts, t-shirts, sweaters, head wear, neckwear, foul weather gear, and jackets]</p> <p>Class 028. First use: First Use: 2004/03/00 First Use In Commerce: 2004/03/00 [Stuffed toys and] toy vehicles</p>		

Attachments	76101133#TMSN.png(bytes) Notice of Opposition - Bayerische Motoren Werke Aktiengesellschaft adv. Hangzhou Donghua Chain Group Co. Ltd .pdf(139918 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/JOHN G FROEMMING/
Name	JOHN G FROEMMING
Date	10/12/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Bayerische Motoren Werke Aktiengesellschaft,	§	
	§	Opposition No. _____
Opposer,	§	
	§	Application Nos. 86/881,671 and
	§	86/881,675
v.	§	
	§	Filed: January 21, 2016
Hangzhou Donghua Chain Group Co., Ltd.	§	
	§	Published: June 14, 2016
Applicant.	§	
_____	§	

NOTICE OF OPPOSITION

Opposer, Bayerische Motoren Werke Aktiengesellschaft (hereinafter “Opposer” or “BMW”), a German corporation with its principal place of business at Petuelring 130, 80809 Munich, Federal Republic of Germany, believes that it will be damaged by the registration of the marks shown in Application Serial Nos. 86/881,671 and 86/881,675, and therefore opposes registration of the same under Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063.

The grounds for opposition are as follows:

1. Application Serial Nos. 86/881,671 and 86/881,675 filed by Hangzhou Donghua Chain Group Co., Ltd. (hereinafter “Applicant” or “Hangzhou”) seek registration of the marks DH-X3 and DONGHUAX3 (hereinafter, the “opposed applications”) for “anti-skid chains for vehicles; chains for cycles; chains for motor cars; clutches for land vehicles; driving chains for land vehicles; gear boxes for land vehicles; land vehicles and structural parts therefor; shock absorbing springs for vehicles; tires for vehicle wheels; transmission chains for land vehicles” in International Class 12.

2. The opposed applications were filed on January 21, 2016 based on Applicant's alleged use of the marks in commerce.

3. The opposed applications were published for opposition in the *Trademark Official Gazette* on June 14, 2016. Opposer timely filed extensions of the opposition periods to October 12, 2016.

4. Opposer BMW is engaged in the business of designing, manufacturing, selling, repairing, and maintaining automobiles, and parts and accessories therefor under various marks, including the trademark X3.

5. BMW has continuously used the trademark X3 in commerce in the United States since long prior to the filing and alleged use of the opposed applications, in connection with the design, manufacture and sale of automobiles, and parts and accessories therefor.

6. Opposer is the owner of Registration No. 2,867,087, registered on July 27, 2004, for the mark X3 covering "passenger motor vehicles and structural parts therefor" in International Class 12, "key rings, and license plates, all made of metal" in International Class 6, and "toy vehicles" in International Class 28. Opposer's Registration No. 2,867,087 is valid and subsisting, and is constructive notice of Opposer's ownership thereof, as provided by § 22 of the Federal Trademark Act of 1946, as amended. Registration No. 2,867,087 is also incontestable under 15 U.S.C. § 1065 and is therefore conclusive evidence of the validity of the X3 mark, and of Opposer's ownership and exclusive right to use the X3 mark in commerce. A copy of the TSDR report for this registration is attached as Exhibit A.

7. Opposer has prominently and extensively used, promoted and advertised the X3 mark for goods in International Class 12 since at least as early as March 2004 through varied promotional and advertising media.

8. As a result of Opposer's long use and extensive and continuous efforts promoting its mark, consumers have come to recognize the X3 mark as uniquely associated with Opposer and an indication of origin in Opposer. As a consequence, Opposer has established valuable goodwill and exclusive rights in the X3 mark.

9. Upon information and belief, Applicant is engaged in the business of selling parts for vehicles including automobiles.

10. Applicant is not affiliated with or sponsored by BMW, and has never been authorized by BMW or any of its subsidiaries, affiliates or authorized agents to use the mark X3.

11. Applicant's alleged marks DH-X3 and DONGHUAX3 so closely resemble Opposer's previously used and registered X3 mark in appearance and commercial impression so as to be likely to cause confusion, mistake or deception under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

12. Applicant's vehicle parts are identical and closely related to the goods offered by Opposer under its mark X3 and covered by Opposer's trademark registration for the mark X3. Therefore, consumers are likely to be confused, mistaken or deceived into the belief, contrary to fact, that the goods offered by Applicant under the DH-X3 and DONGHUAX3 marks emanate from and/or are in some way sponsored or approved by Opposer, and/or that Applicant is somehow affiliated with Opposer, thereby damaging Opposer.

13. If Applicant's marks are registered, Applicant will receive a *prima facie* nationwide exclusive right to use marks that are likely to cause confusion as to source, sponsorship and affiliation with Opposer's mark X3 in commerce and, as such, would be inconsistent with Opposer's rights.

WHEREFORE, for the foregoing reasons, Opposer respectfully requests that the present opposition be sustained in favor of BMW and Application Serial Nos. 86/881,671 and 86/881,675 be refused registration.

Respectfully submitted,

Date: October 12, 2016

By: /s/ Jessica D. Bradley
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Attorneys for Opposer
Bayerische Motoren Werke Aktiengesellschaft

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Applicant, by mailing said copy via DHL on the 12th of October 2016 to:

Xiaolin Lu
Rm 713 7/F, Yue Sang Hse, Kin Sang Est
Tuen Mun Nt Hong Kong
yep5jr0nd@gmail.com

and a courtesy copy via email to:

Karen Chow
ChinaHongKong IP Limited
3011-12, 30/F, Office Tower, Convention Plaza,
1 Harbour Road
Hong Kong
kchow@chinahk-ip.com

/s/ Aryane R. A. Garansi

Exhibit A

Generated on: This page was generated by TSDR on 2016-10-10 16:27:06 EDT

Mark: X3

X3

US Serial Number: 76101133

Application Filing Date: Aug. 02, 2000

US Registration Number: 2867087

Registration Date: Jul. 27, 2004

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Jun. 14, 2014

Publication Date: Jan. 15, 2002

Notice of Allowance Date: Apr. 09, 2002

Mark Information

Mark Literal Elements: X3

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: [Money clips,] key rings, and license plates, all made of metal

International Class(es): 006 - Primary Class

U.S Class(es): 002, 012, 013, 014, 023, 025, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 2004

Use in Commerce: Mar. 2004

For: Passenger motor vehicles and structural parts therefor; [bicycle racks for vehicles]

International Class(es): 012 - Primary Class

U.S Class(es): 019, 021, 023, 031, 035, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 2004

Use in Commerce: Mar. 2004

For: [Ashtrays, cigarette] [and cigar] [lighters, cigarette] [and cigar] [holders, lapel pins, tie clips, watches, all made of precious metal]

International Class(es): 014 - Primary Class

U.S Class(es): 002, 027, 028, 050

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Mar. 2004

Use in Commerce: Mar. 2004

For: [Appointment books, ball-point pens, and coin holders]

International Class(es): 016 - Primary Class

U.S Class(es): 002, 005, 022, 023, 029, 037, 038, 050

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Mar. 2004

Use in Commerce: Mar. 2004

For: [Umbrellas, luggage, and wallets]

International Class(es): 018 - Primary Class

U.S Class(es): 001, 002, 003, 022, 041

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Mar. 2004

Use in Commerce: Mar. 2004

For: [Shirts, t-shirts, sweaters, head wear, neckwear, foul weather gear, and jackets]

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Mar. 2004

Use in Commerce: Mar. 2004

For: [Stuffed toys and] toy vehicles

International Class(es): 028 - Primary Class

U.S Class(es): 022, 023, 038, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 2004

Use in Commerce: Mar. 2004

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Bayerische Motoren Werke Aktiengesellschaft

Owner Address: Petuelring 130
80809 Muenchen
GERMANY

Legal Entity Type: CORPORATION

State or Country Where Organized: GERMANY

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Aimee Gessner

Attorney Primary Email Address: tm-d@bmw.de

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Aimee Gessner
Bayerische Motoren Werke Aktiengesellschaft
Petuelring 130
Dept. AJ-55 (Trademarks)
80809 Munich
GERMANY

Correspondent e-mail: tm-d@bmw.de

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jun. 24, 2014	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 24, 2014	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jun. 14, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Jun. 14, 2014	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	75184
Jun. 14, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	75184
Jun. 14, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75184
May 28, 2014	TEAS SECTION 8 & 9 RECEIVED	
Jun. 14, 2010	REGISTERED - PARTIAL SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	76293
Jun. 11, 2010	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	76293
Jun. 11, 2010	TEAS SECTION 8 & 15 RECEIVED	
Sep. 22, 2008	ATTORNEY REVOKED AND/OR APPOINTED	
Sep. 22, 2008	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
May 22, 2008	CERTIFICATE OF CORRECTION ISSUED	
May 22, 2008	ASSIGNED TO PARALEGAL	76293
Jan. 15, 2008	SEC 7 REQUEST FILED	
Jan. 15, 2008	PAPER RECEIVED	
Jul. 27, 2004	REGISTERED-PRINCIPAL REGISTER	
May 08, 2004	ASSIGNED TO EXAMINER	74781
May 08, 2004	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
May 05, 2004	STATEMENT OF USE PROCESSING COMPLETE	
Apr. 14, 2004	USE AMENDMENT FILED	
Apr. 28, 2004	CASE FILE IN TIGRS	
Apr. 14, 2004	PAPER RECEIVED	
Feb. 10, 2004	EXTENSION 4 GRANTED	
Feb. 10, 2004	EXTENSION 4 FILED	
Feb. 10, 2004	PAPER RECEIVED	
Sep. 24, 2003	EXTENSION 3 GRANTED	
Sep. 03, 2003	EXTENSION 3 FILED	
Sep. 03, 2003	PAPER RECEIVED	
Mar. 17, 2003	EXTENSION 2 GRANTED	
Dec. 03, 2002	EXTENSION 2 FILED	
Feb. 26, 2003	PAPER RECEIVED	
Feb. 19, 2003	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Dec. 03, 2002	PAPER RECEIVED	
Nov. 04, 2002	EXTENSION 1 GRANTED	
Sep. 24, 2002	EXTENSION 1 FILED	
Sep. 24, 2002	PAPER RECEIVED	
Apr. 09, 2002	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Jan. 15, 2002	PUBLISHED FOR OPPOSITION	
Dec. 26, 2001	NOTICE OF PUBLICATION	
Aug. 13, 2001	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 13, 2001	ASSIGNED TO EXAMINER	74781
Apr. 24, 2001	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Mar. 26, 2001	NON-FINAL ACTION MAILED	
Mar. 15, 2001	ASSIGNED TO EXAMINER	78047
Feb. 26, 2001	ASSIGNED TO EXAMINER	72152

Maintenance Filings or Post Registration Information

Affidavit of Section 8 - Accepted
Continued Use:

Affidavit of Section 15 - Accepted

Incontestability:

Renewal Date: Jul. 27, 2014

**Change in
Registration:** Yes

**Amendment to a
Registration/Renewal
Certificate:** Statement(s): Column 1, line 16 and 17, "and cigar" is deleted.

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Jun. 14, 2014